

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 15 of 22

Remarks/Arguments

Introduction

Claims 1-45 are rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner states that claims 1 and 14 recite the limitation "automatically ranking and switching/selecting the communication modes" and "the communication modes being user selectable", which the Examiner states are controversies to each other, unclear about the claimed functionality and make the claim indefinite. In response, Applicant has amended claims 1 and 14 and 46 to remove any such inconsistency.

The Examiner has also rejected claims 1-59 under 35 USC §103 (a) as unpatentable over US Patent No. 6,717,936 to Srinivasan (hereinafter Srinivasan) in view of U.S. Patent No. 6,717,936 to Parker (hereinafter Parker) and U.S. Patent No. 5,212,550 to Segur (hereinafter Segur). The Examiner contends that your invention is obvious in view of the cited references. In response, independent claims 1, 14 and 46 have been amended.

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 16 of 22

Section 112 Rejections

Claims 1-45 are rejected under 35 U.S.C. §112, second paragraph. Claims 1, 14, and 46, have been amended, Applicant respectfully submits that this rejection is now moot in view of the amendments.

Response to Rejections under 35 U.S.C. 103 (a)

Srinivasan

Srinivasan describes a system for transferring personal communications over a variety of user selectable networks, providing a user with the ability to control and interface a variety of communication devices through a central networking device. Srinivasan describes a communication system for directing communications from a particular user to another particular user. In column 2, line 42 - 59, Srinivasan states:

“In order to use the current system, the person seeking to establish a line of communication with a subscriber, accesses the server either through a telephone connection over a modem or through the worldwide web. Once a connection is established with the server, a screen display may be provided through which the system user submits information to identify the particular person to be contacted. If sufficient information is provided, and the person to be contacted is a subscriber of this system, the name will be located in the database and the system user will be provided with a screen display which includes the subscriber's name and a list

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 17 of 22

of modes of communications for the subscriber. For example, a series of icons may be included in the screen display, where each icon is a picture of the desired communication method. The system user may then select the icon representing the desired mode of communication and the server then executes the internal functions which will establish the desired mode of communication between the system user at the user interface and the subscriber.”

In contrast, the present invention as currently defined by amended independent claims 1, 14 and 46 is directed to a communication system using networked electronic stations for transmitting messages to and from a plurality of stations. In contrast to Srinivasin however, in the present invention, the messages are automatically routed to a user in accordance with the user communication modes and communication data profile. Srinivasin fails to disclose this feature, and is instead directed to converting and transmitting messages in response to specific user inputs. Nowhere in Srinivasin is it disclosed to automatically route to a user in accordance with an automatically established user communication profile which can prioritize by both communication mode as well as communication data type, in other words the type of message being sent or received.

Accordingly, Srinivasan fails to teach or suggest a communication system in accordance to the present invention as in amended claims 1, 14 and 46.

Applicant: Bellotti, Alberto
Appl. No. 09/765,092
Filed: January 17, 2001
Page 18 of 22

Parker

Parker describes a system, referred to as a "service selection program" for obtaining a classification label for a service provider selected for the current communication mode and, based on the mapping of this classification label into the service provider selection model determine a preference level for the service provider and then transferring messages based upon the preference level through the designated service provider.

Parker fails to cure the deficiencies of Srinivasin in that it does not teach or suggest directing messages between communication units in response to an automatically generated ranking that is developed from user inputs with respect to **both communication modes as well as communication data** (in other words, the message itself). Therefore, the combination of Srinivasin and Parker fail to teach, suggest or disclose the present invention in accordance to the amended claims 1, 14, and 46.

Segur

Segur describes a system for converting messages from one format to another in response to user entered commands and then transferring the converted message to the user prompted communication device. Segur describes a communication system for directing communications from a particular user to another particular user. In column 2, line 12-26, Segur states:

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 19 of 22

“When a subscriber desires access to his messages, he transmits a retrieval query from any of a plurality of message receiving devices 26-34 to the client-server 10. The message receiving devices 26-34 include, PDAs 26, pagers 28, cellular phones (cellular voice, cellular voice data) 30, portable computers 32, and fax machines 34. The client-server 10 senses the return address (routing address), communication data format and communication channel of the message receiving device (subscriber unit) 26-34. The client-server 10 then sends a summary of the stored messages, including any priority information. The subscriber can then select the stored messages he wants transmitted to him. The client-server converts the selected messages to the data format of the subscriber device and transmits the messages to the subscriber unit.”

In contrast, the present invention as currently defined by amended independent claims 1, 14 and 46 is directed to a communication system using networked electronic stations for transmitting messages to and from a plurality of stations. In contrast to Segur however, in the present invention, the messages are automatically routed to a user in accordance with the user communication modes and communication data profile. Segur fails to disclose this feature, and is instead directed to converting and transmitting messages in response to specific user inputs. Nowhere in Segur is it disclosed to automatically route to a user in accordance with an

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 20 of 22

automatically established user communication profile which can prioritize by both communication mode as well as communication data type, in other words the type of message being sent or received.

Segur therefore fails to cure the deficiencies of Srinivasin and Parker alone or in combination in that, it does not teach or suggest directing messages between communication units in response to an automatically generated ranking that is developed from user inputs with respect to **both communication modes as well as communication data** (in other words, the message itself). Therefore, the combination of Srinivasin and Parker and Segur fail to teach, suggest or disclose the present invention in accordance to the amended claims 1, 14, and 46.

In establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* Thus, the express teachings of Srinivasan and Segur, which would lead one away from the invention defined by claims 1, 14, and 46 may not be ignored during examination.

To arrive at the present invention as defined by claims 1, 14, and 46, the Action not only ignored the express teaching of Srinivasan and Segur, but also engaged in hindsight

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 21 of 22

reconstruction because none of the documents of record teach or suggest the process as claimed, as the cited references, i.e., Srinivasan, Segur and Parker, all are directed to communications systems that transfer messages in response to user prompt in contrast to the present invention. It is well established that hindsight reconstruction of a reference does not present a *prima facie* case of obviousness and any attempt at hindsight reconstruction using Applicants' disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445-46 (Fed. Cir. 1993).

Thus, Srinivasan, Segur and Parker, individually or in combination, fail to teach the present invention as set forth in claims 1, 14, and 46.

Accordingly, Applicant respectfully submits that the present invention is patentably distinct over the combination of Srinivasan, Segur and Parker.

Summary

Therefore, Applicant respectfully submits that independent claims 1, 14 and 46 and all claims dependent therefrom, are patentably distinct. This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Applicant: Bellotti, Alberto
Appln. No. 09/765,092
Filed: January 17, 2001
Page 22 of 22

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Respectfully submitted,



Stephen Cannavale
Registration No.: 44,585
Attorney for Applicant(s)

HOFFMANN & BARON
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700